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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,298	06/08/2006	Rudolf Berger	72.107	5075

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BOYLE FREDRICKSON S.C.
840 North Plankinton Avenue
MILWAUKEE, WI 53203

EXAMINER

SMITH, SCOTT A

ART UNIT	PAPER NUMBER
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3721

NOTIFICATION DATE	DELIVERY MODE
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12/04/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@boylefred.com

Office Action Summary	Application No. 10/596,298	Applicant(s) BERGER ET AL.	
	Examiner Scott A. Smith	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment filed on 10/22/08 has been entered and the remarks therein have been considered.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 has been amended to recite that the guide device is disposed between the handle and housing that allows relatively uninhibited movement of the handle device relative to the handle housing in the working direction. However, this mode of operation is not originally set forth in the specification. Such conditions can be inferred, but such disclosure is not explicitly set forth. In fact, the specification teaches the contrary. For example, on page 7, lines 15-17, the guide device is disclosed as enabling a guiding of the handle relative to the housing transverse to the working direction, as well as in a rotational direction. Also, on page 8, lines 18-21, the rollers are disclosed as being elastic such as to allow such transverse movement between the handle and housing. Further, the spring 13 would also be

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effective to inhibit longitudinal movement of the handle relative to the housing. This being contradictory to the claims as amended.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite since "the handle housing" on line 9 lacks proper antecedent basis. Perhaps this should be changed to "hammer housing". On line 10, it appears that "the guide device" should be changed to "handle device" in order to more accurately recite the invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 9, 10 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Harada et al. '466.

Harada et al. '466 discloses the percussion drill hammer as claimed comprising a hammer housing 1, 15, a handle device surrounding at least a portion of the housing and including a handle 2, 12, and a guide device including rolling elements 4 effective between the hammer housing and the handle device located laterally on the housing, as

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broadly claimed, and effecting a spring characteristic transverse to a working direction, wherein the guide device allows relatively uninhibited movement of the handle relative to the housing in a working direction and inhibits lateral and rotational movement between the handle and housing, as broadly claimed.

7. Claims 1, 2, 4, 9, 10, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by UK Patent Application '045.

UK Patent Application '045 discloses the percussion drill hammer as claimed comprising a hammer housing 11, a handle device including a handle 12, and a guide device including rolling elements 7 effective between the hammer housing and the handle device located laterally on the housing, as broadly claimed, and effecting a spring characteristic transverse to a working direction, wherein the guide device allows relatively uninhibited movement of the handle relative to the housing in a working direction and inhibits lateral and rotational movement between the handle and housing, as broadly claimed.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5-8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harada et al. '466 or UK Patent Application '045 in view of Dunn '014.

Harada et al. '466 and UK Patent Application '045 lack the specifically claimed rolling elements and tracks. Dunn '014 discloses a related reciprocating tool comprising a handle 12 guided reciprocally upon a tool member 11,31, and a guide device including rolling members 30 in cooperating tracks 33, 32 between the handle and tool member. In view of the teachings of Dunn '014, it would have been obvious to one skilled in the art to provide the devices of Harada et al. '466 or UK Patent Application '045 with the specifically claimed rolling elements and tracks for the guide arrangement in order to more effectively guide the elements.

Response to Arguments

10. Applicant's arguments filed on 10/22/08 have been fully considered but they are not persuasive. Applicant argues that Harada fails to disclose the invention since the movement of the handle relative to the housing is limited. Although this may be correct, Harada is deemed to disclose the invention as claimed, since Harada allows longitudinal movement with little resistance, and the orientation of the rollers would inhibit transverse and rotational movement of the handle relative to the housing. Also, as set forth above in paragraph 2, applicants disclose resilient rollers which allow for transverse and rotational movement. Applicant similarly argues with respect to UK Patent '045. It is the examiner's position that the rollers 7 of UK Patent '045 would allow for substantially longitudinal movement of the handle relative to the housing, as opposed to transverse or rotational movement therebetween. This is illustrated by the

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relative position change between the handle and housing in Fig. 1 in relation to Fig. 2.

Therefore, inasmuch as applicant's invention functions as claimed, the references to Harada and UK Patent '045 are likewise deemed to function equivalently.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the attached PTO-892 for related art.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott A. Smith whose telephone number is 571-272-4469. The examiner can normally be reached on 5:30-4:00 Tues.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S. Smith

/Scott A. Smith/
Primary Examiner, Art Unit 3721